

27 SEP 2000



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In re Application of
HUNIG
U.S. Application No.: 09/449,077
Filing Date: 24 November 1999
Attorney Docket Number: 11254/52641
For: HUMAN CD28 SPECIFIC MONOCLONAL
ANTIBODIES FOR ANTIGEN-NON
SPECIFIC ACTIVATION OF
T-LYMPHOCYTES

DECISION ON PETITION

UNDER 37 CFR 1.182

This decision is in response to applicant's, "Petition for Application to be Treated as a 371" filed 02 March 2000 and sent by facsimile to the PCT Legal Office on 06 June 2000 which is being treated as a petition under 37 CFR 1.182. Applicant has paid the \$130.00 petition fee.

BACKGROUND

On 24 November 1999, applicant filed with the United States Patent and Trademark Office (USPTO) a transmittal letter and stated that the application claimed the benefit of prior U.S. application(s). Accompanying the transmittal letter was a certified copy of application, PCT/DE98/01499, a fee calculation sheet, and a check in the amount of \$760.00 for the basic filing fee. Applicant sought to amend the Specification by inserting as the first line the sentence, "This patent application claims priority to PCT Application Number PCT/DE98/01499 with an international filing date of May 28, 1998. Applicant did not include an oath or declaration.

On 10 January 2000, applicant was mailed a Notice to File Missing Parts of Application (Form PTO-1533) informing applicant of the need to file an executed oath or declaration.

On 31 January 2000, applicant filed an executed power of attorney.

On 02 March 2000 applicant filed the Petition for Application to be Treated as a 371 considered herein.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-120 of the Manual of Patent Examining Procedure (MPEP) states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

Applicant's reference to 37 CFR 1.53(b) in the transmittal letter of 24 November 1999 is inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371. Accordingly, the original papers deposited on 24 November 1999 were correctly treated as a filing under 35 U.S.C. 111(a).

A review of the application file, and specifically the present petition, reveals that applicant has not provided any showing of sufficient cause which would justify the conversion of the present application, which has been properly processed as an application filed under 35 U.S.C. 111(a), to a national stage application filed under 35 U.S.C. 371.

Therefore, in view of the facts that the originally filed application papers were properly processed as a filing under 35 U.S.C. 111(a) and that applicant has failed to demonstrate sufficient cause which would justify such a conversion, the petition may not be properly granted.

CONCLUSION

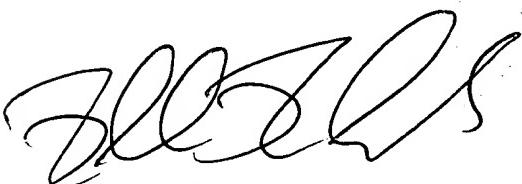
For the reasons stated above, the petition to convert the application from a 35 U.S.C. 111(a) filing to a national stage application under 35 U.S.C. 371 is **DISMISSED** without prejudice.

In that the prior PCT application and the present application were copending on the filing date of the present application, applicant is entitled to claim benefit under 35 U.S.C. 120 and 119 to the prior PCT and foreign applications respectively. Applicant needs to file a new declaration which claims 35 U.S.C. 120 benefit to the PCT application and 35 U.S.C.

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119 benefit to the foreign case. The new declaration must not reference 35 U.S.C. 371 as was the case with the originally filed declaration. Further, in order to perfect the claim for foreign priority under 35 U.S.C. 119 applicant must file a certified copy of the prior German application.

The application is being returned to Group Art Unit 1643.



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